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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/581,050	12/27/1995	TAKAHISA UEDA		6204

23364 7590 03/03/2005

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EXAMINER
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DEPUMPO, DANIEL G

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 08/581,050	Applicant(s) UEDA, TAKAHISA	
	Examiner Daniel G. DePumpo	Art Unit 3611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-11, 13, 14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3, 4, 6-11, 13, 14 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1, 3, 4, 6-11, 13, 14 and 16-20 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.
2. A Board of Patent Appeals and Interferences decision in an application has *res judicata* effect and is the “law of the case” and is thus controlling in that application and any subsequent, related application. Therefore, a submission containing arguments without either an amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection. See MPEP § 706.03(w) and 1214.01.

Claim 2 is finally rejected under *res judicata*, in view of the Board decision of 2/27/04.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda ‘030 in view of Ogino.

Ueda discloses all the features including the use of expanded graphite. In Ueda, it is noted that since the narrow fibers are laminated with the graphite, the graphite surrounds the fibers. Also, fig. 8 clearly shows that the graphite surrounds the fibers when the packing is complete. While Ueda does disclose that the graphite sheets and reinforcing fiber are “laminated” (which usually involves adhesive bonding), adhesives are not explicitly mentioned. However, Ogino teaches the use of longitudinally disposed fibers which are laminated with expanded graphite sheets by adhesives for the purpose of reinforcing the graphite sheets.

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Therefore, it would have been obvious, in view of Ogino, to use adhesive to laminate the graphite sheets and fibers of Ueda together.

5. Claim 2 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Case in view of Schnitzler.

Case discloses all claimed features except for the use of expanded graphite. Case discloses a packing made of braided yarns wherein the yarns are made up of twisted or braided fibers and graphite. Case also discloses the use of TFE binder which acts as an adhesive to bind the graphite to the fibers (also, see Ueda '030 col. 5, lines 19-20). Schnitzler teaches the well known use of expanded graphite which is preferred for use in packings due to its mechanical properties. Therefore, it would have been obvious, in view of Schnitzler, to utilize expanded graphite due to its preferred mechanical properties and commercial availability.

6. Applicant's arguments filed 11/15/05 have been fully considered but they are not persuasive.

In the brief remarks filed with the RCE, applicant refers to the response filed December 13, 2004, and states that "it is necessary that both issues be considered and discussed so that a record can be developed with respect to these issues in the event of a further appeal". It is not entirely clear what applicant considers to constitute "both issues". It is noted that the response filed December 13, 2004 in turn refers to the Memorandum filed July 28, 2004, which in turn refers to "Enclosure D" filed March 6, 2003. Nevertheless, this convoluted path leads us to applicant's discussion of "Enclosure D" in the appeal brief filed March 6, 2003. This discussion was rebutted in the Examiner's Answer mailed April 23, 2003 (see the last paragraph of page 5). Applicant basically repeats this discussion in the Memorandum filed July 28, 2004. In this

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Memorandum, applicant argues that the graphite in Enclosure D (applicant purports this to be the arrangement found in Figure 7 of Ueda) does not surround the fiber because the entire circular outer surface of the fiber is not engaged with expanded graphite particles. This is not persuasive because the claims do not recite that the fiber is engaged with the graphite around the entire circular outer surface of the fiber. Nevertheless, even if such a limitation is read into the claims for some reason, it is clear that the graphite sheets of Ueda will “surround the fiber when the sheets are” are “deflected into engagement” (depicted in Enclosure D) during lamination. The claim does not require the graphite to “engage” the fibers around the entire surface of the fibers, as argued applicant. Instead, the claims merely require the graphite to “surround” the fibers. Moreover, it is noted that in fig. 8 Ueda clearly shows that the graphite surrounds the fibers when the packing is complete.

In the remarks filed 1/15/05, applicant states that “[c]laim 2 has been further amended to clarify that the graphite surrounds each reinforcing fiber yarn, *not unlike* the arrangement shown in the Enclosure D of record” (emphasis). Applicant appears to be conceding that the claim reads on Enclosure D, which applicant has urged is an illustration of the arrangement found in Figure 7 of Ueda.

Finally, it is noted that applicant has not addressed the rejection based on Case.

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

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See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. DePumpo whose telephone number is 703 308-1113. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703 308 1113. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel G. DePumpo  
Primary Examiner  
Art Unit 3611

dgd  
2/28/05